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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,271	10/26/2000	Yoichiro Sako	6715/60007	2353

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EXAMINER	
TRAN, TONGOC	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/581,271	SAKO ET AL.	
	Examiner	Art Unit	
	Tongoc Tran	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-4,7-9,11,13-15,18-20 and 23-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-4,7-9,11,13-15,18-20 and 23-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/5/2005 has been entered. Claims 2-4, 7-9, 11, 13-15, 18-20 and 23-44 have been amended. Claims 2-4, 7-9, 11, 13-15, 18-20, 23-44 are pending.

Response to Arguments

2. In Applicant's remark, pages 21, *Applicant states that "the embodiment of the present invention stops the outputting of digital audio data when the external apparatus has the capability of making copies and recording that output digital data. As explained in the present specification at page 13, lines 3-7, the reproduced data from the optical disc is outputted as an analog audio signal through the D to A converter. when the external apparatus has a function of copying data, the control circuit opens the switch 13 so that the digital audio data is not output, this however does not effect the output of the analog audio signal representing the signal being reproduced by the reproducing apparatus. Thus even when the results of the determination of the external apparatus determines that the data transmission to the external apparatus should be prohibited, the reproduced audio signal is made available nonetheless. That is, the user can enjoy*

the reproduced signal even though the user is prohibited from making a copy of the signal. The apparatus can stop transmission of output data to the external apparatus during a time when the reproducing means reproduces and outputs the data".
Examiner finds this reference in the teaching of the Specification to be inconsistent with the original disclosure (see U.S.C. 112 rejection below for detail explanation).

In response to Applicant's remark in respect to claim 41, Applicant contends that that Ottenson et al. does not suggest the feature of "fee charging information is stored in a recording medium together with the data to be transmitted to an external apparatus and fee charging information is updated whenever the data transmission has occurred". Examiner notes that the cited claimed limitation does not recite as Applicant presented. Rather the claimed limitation recites, "a fee charging control step is to perform the fee charging process by updating, in accordance with the fee to be charged, data recorded on the recording medium and corresponding to a sum of fees that can be charged for the recording medium", (Ottenson, col. 8, lines 5-9, e.g. each subsequent viewing of the downloaded presentation is detected by the intelligent set-top control unit, thus allowing for automatic billings of each program presentation to the customer's account...). The cited limitation of "data recording on the recording medium is interpreted as the downloaded data that is being outputted and the fee is charged according. Examiner further taken the office notice for the cited limitation of "stop the transmission of the output data through the interface when the data corresponding to the sum of fee reaches or exceeds a predetermined value". This feature is well known in the art, e.g. controlling output according to what the consumer pays to view, therefore, it would have

been obvious to one of ordinary skill in the art to conclude feature of controlling the amount of output according what is requested.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-4, 7-9, 11, 13-15, 18-20, 23, 31, 39-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification that Applicant referencing in the remark to support the amended claims appears to be inconsistent with the original Specification and the drawings. Even thought an amendment to the Specification has been made to correspond to the label items in the steps illustrated in the drawings. However, the support which Applicant rely upon to amend the claims appears to be based on the assumption that the original disclosure is teaching the steps S5 and S3 to be performed simultaneously. In other words, if Fig. 2, step S4 is true (or yes), digital audio signal will not be output but analog audio signal will. Examiner believes this assumption is in error based on the original disclosure of the Specification, which was inadvertently disclose the S3 to be S5 as illustrated in Fig. 2. In order to be consistent with the teaching of the

original drawings and the Specification, the disclosure where the control circuit outputting the analog audio signal should occur only when the condition of S4 becomes true or when no copying function exist, then the output of analog audio signal (output data) takes place. Therefore, based on the rationale stated above, Examiner is taking the position as clearly illustrated in Fig. 2, where in step S4, if the condition is true that an external apparatus can copy data, no output of data will be transmitted and when the condition of S4 indicated that no external apparatus can copy data, analog audio signal will be transmitted.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2-4, 7-9, 11, 13-15, 18-20 and 23-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Shear (US Patent Application Publication US200110042043).

In respect to claim 2, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

Reproducing means for reproducing data (see Fig. 14, e.g. laptop, pc.);

External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus and control means for controlling stopping transmission of output data to an external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means during a time when said reproducing means reproduces and outputs the data, (Shear, [0282]) wherein the external-apparatus identifying means determines whether the external apparatus is a data storage apparatus that has a build-in memory means for storing data input through the interface, and the control means stops the transmission of output data to the external apparatus when the external-apparatus identifying means determines that the external apparatus is the data storage apparatus having the built-in memory (see Shear, [0003, 0030-0031, 0054, 0282, 0168]).

In respect to claim 3, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

Reproducing means for reproducing data (see Fig. 14, e.g. laptop or pc); External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and control means for controlling stopping transmission of output data to the external apparatus through the interface, in accordance with a result of determining the type of the external-apparatus identifying means during a time when said reproducing means reproduces and outputs the data (see Shear, [0282, 0056), wherein the external-

apparatus identifying means determines a version of the external apparatus, and the control means controls stopping the transmission of output data to the external apparatus through the interface, in accordance with the version of the external apparatus (see Shear [0070, 0056]).

In respect to claim 4, Shear discloses a data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

Reproducing means for reproducing data (see Fig. 14, e.g. laptop, pc) External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus, and control means for controlling stopping transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means during a time when said reproducing means reproduces and outputs the data, (see Shear, [0282]), wherein the external-apparatus; identifying means determines whether the external apparatus is a copyright-related apparatus, and the control means controls the transmission of output data to the external apparatus through the interface, in accordance with result of determination (see Shear, [0054, 0057]).

In respect to claim 7, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and

Control means for controlling stopping transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means during a time when said reproducing means reproduces and outputs the data (see Shear 0282), wherein the control means controls the transmission of output data to the external apparatus through the interface, in accordance with an amount of the output data to be transmitted to the external apparatus (see Shear, [0092]).

In respect to claim 8, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

Reproducing means for reproducing data (see Fig. 14, e.g. laptop, pc).

External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and

Control means for controlling transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means during a time when said reproducing means reproduces and outputs the data (see Shear, [0282]),

wherein the control means controls the transmission of output data to the external apparatus through the interface, in accordance with a speed at which the output data is to be transmitted to the; external apparatus (see Shear, [0179]).

In respect to claim 9, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses; External-apparatus identifying means for determining a type of an external apparatus connected to the interface; and outputting data representing the type of the external apparatus; and control means for controlling stopping transmission of output data to the external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means (see Shear, [0282]) wherein data-reproducing means is provided for reproducing the output data from a recording medium, and the control means controls the transmission of output data to the external apparatus through the interface, in accordance with the recording medium (see Shear, [0220]).

In respect to claim 11, Shear discloses the data transmitting apparatus, comprising:

An interface that can be connected to various external apparatuses;

Reproducing means for reproducing data (see Fig. 14, e.g. laptop or pc); External-apparatus identifying means for determining a type of an external apparatus connected to the interface and outputting data representing the type of the external apparatus; and control means for controlling transmission of output data to the

external apparatus through the interface, in accordance with the result of determining the type of the external-apparatus identifying means during a time when said reproducing means reproduces and outputs the data (see Shear, 01 282]), further comprising- fee-charging means [is provided] for charging a fee in accordance with the transmission of output data through the interface, and the control means controls a fee-charging process performed by the fee-charging means, in accordance with the result of determining made by the external-apparatus identifying means of the type of the external apparatus (see Shear, [0092]).

In respect to claims 13-15 and 18-20, the claims limitations are method claims that are substantially similar to apparatus claims 3-4 and 7-9 and 11. Therefore, claims 13-15, and 18-20 are rejected based on the similar rationale.

In respect to claim 23, Shear discloses a data apparatus comprising:
a plurality of interfaces of different types; and control means for controlling stopping of transmission of output data through the plurality of interfaces in accordance with the types of interfaces (see Shear, [0039, 0282 and 0220]).

In respect to claims 24-30, the claim limitations are substantially similar to claims 7-11. Therefore, claims 24-30 are rejected based on the similar rationale. In respect to claims 31-40, the claim limitations are method claims that are substantially similar to apparatus claim 23-30. Therefore claims 31-40 are rejected based on the similar rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shear et al. (U.S. Patent Application Publication, US 200110042043) in view of Ottesen et al. (U.S. Patent No. 5,654,747).

In respect to claim 41, Shear discloses a data transmitting method for use in a data transmitting apparatus for transmitting, though an interface, output data reproduced from a recording medium, the method comprising: a fee-charging control step of performing a fee-charging process in accordance with the transmission of output data through the interface and controlling the transmission of output data (see Shear [0092]). Shear does not explicitly disclose wherein the fee-charging control step is to perform the fee-charging process by "updating", in accordance with the fee to be charged, data recorded on the recording medium and corresponding to a sum of fees that can be charged for the recording medium, and to stop the transmission of output data through the interface when the data corresponding to the sum of fees reaches or exceeds a predetermined value during a time when the output data is being reproduced and outputted. However, Ottensen discloses communicating a billing signal to the information network in response to each presentation of a downloaded source program (updating) (see Ottensen, col. 7, line 55-col. 8, line 14). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Ottesen by updating the billing information as information is downloaded from source with Shear's teaching of billing for the fee charging control system in order to allow for automatic billing for each program presentation to the customer's account (see Ottensen, col. 8, lines 5-9). Furthermore, Shear does not explicitly disclose stop the transmission of output data when the data corresponding to the sum of fees reaches or exceeds a predetermined value. However, Official Notice is taken that pay for view with predetermined selection of program by subscriber is old and well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate stopping output when data corresponding to the sum of fees reaches as in preselect pay for view program with Shear's fee charging control system in order to output program according to subscriber's predetermined on selected program they are interested to view.

In respect to claims 42-44, the claim limitations are substantially similar to claim 41. Therefore, claims 42-44 are rejected based on the similar rationale.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
Art Unit: 2134

March 6, 2006

MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137